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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/807,469	03/24/2004	Katsuya Miyata	62758-075	2918

<sup>7590</sup>  
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600 13th Street, N.W.  
Washington, DC 20005-3096

04/23/2009

EXAMINER
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TAYLOR, JOSHUA D

ART UNIT	PAPER NUMBER
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2426

MAIL DATE	DELIVERY MODE
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04/23/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/807,469	<b>Applicant(s)</b> MIYATA, KATSUYA	
	<b>Examiner</b> JOSHUA TAYLOR	<b>Art Unit</b> 2426	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 21 January 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 3,4,7-14, 18 and 20-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 3,4,7-14, 18 and 20-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

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**DETAILED ACTION**

***Response to Arguments***

Applicant's arguments, filed 1/21/2009, with respect to the rejection(s) of claim(s) under 35 USC § 103 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of 35 USC § 102.

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 18, 20, and 24-25 rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims recite a method which is not tied to another statutory category, such as a machine. Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 3, 4, 7-9, 11, 13, 18 and 20-25 are rejected under 35 U.S.C. 102(e) as being anticipated by Sin (Pat. No.: US 7,227,583).

Regarding claim 3, Sin discloses **a communication terminal comprising: a video reproduction device configured to carry out a video reproduction** (Fig. 2, elements 25, 28 and 29, column 4, line 65 – column 5, line 8); **a communication device configured to carry out a communication** (Fig. 2, elements 27 and 24, column 5, lines 52-55. The control unit 27 communicates with the database 24.); **and a reproduction-end-time acquisition device configured to acquire an end time of the video reproduction carried out by said video reproduction device** (Fig. 2, element 27, column 5, lines 64-67); **wherein, in the event of an incoming communication from a communication partner in the course of the video reproduction carried out by said video reproduction device, said communication partner is informed of the end time of said video reproduction** (Fig. 2, elements 27 and 24, column 5, lines 52-67. Control unit 27 communicates with the database 24, and is informed of the end time of the currently broadcast program.).

Regarding claim 4, Sin discloses **a communication terminal comprising: a video reproduction device configured to carry out a video reproduction** (Fig. 2, elements 25, 28

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and 29, column 4, line 65 – column 5, line 8); **a communication device configured to carry out a communication** (Fig. 2, elements 27 and 24, column 5, lines 52-55. The control unit 27 communicates with the database 24.); **a reproduction-end-time acquisition device configured to acquire an end time of the video reproduction carried out by said video reproduction device** (Fig. 2, element 27, column 5, lines 64-67); **a storage device configured to store an incoming-reporting condition indicating whether a video reproduction takes precedence of an operation to report an incoming communication or said operation to report an incoming communication takes precedence of said video reproduction** (Fig. 2, elements 26 and 27, column 6, lines 3-21. The stored condition is that if the currently broadcast program has more than 5 minutes remaining, the video reproduction takes precedence, and if the currently broadcast program has less than 5 minutes remaining, the incoming communication takes precedence.); **and a setting device configured to set said incoming-reporting condition** (Fig. 2, element 27, column 6, lines 3-27, fig. 3, element S34. The condition is set based on the time remaining in the currently broadcast program.); **wherein, in the event of an incoming communication from a communication partner in the course of the video reproduction carried out by said video reproduction device: said communication partner is informed of the end time of said video reproduction if said incoming-reporting condition is set to indicate that said video reproduction takes precedence of an operation to report said incoming communication** (Fig. 2, elements 27 and 24, column 5, lines 52-67. Control unit 27 communicates with the database 24, and is informed of the end time of the currently broadcast program.); **and said incoming communication is reported if said incoming-reporting condition is set to indicate that an operation to report said incoming communication takes**

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**precedence of said video reproduction** (Fig. 3, element S34, column 6, lines 3-27. If less than 5 minutes are remaining, the viewer is informed of the imminent channel change, which is a report of the communication.).

Regarding claim 7, Sin discloses **a communication terminal comprising: a TV-broadcast receiving device configured to receive a TV broadcast** (Fig. 2, elements 25, 28 and 29, column 4, line 65 – column 5, line 8); **a display configured to display an image of a TV broadcast received by said TV-broadcast receiving device** (Fig. 2, elements 25, 28 and 29, column 4, line 65 – column 5, line 8); **a communication device configured to carry out a communication** (Fig. 2, elements 27 and 24, column 5, lines 52-55. The control unit 27 communicates with the database 24.); **and a program-end-time acquisition device configured to acquire an end time of a program of a TV broadcast received by said TV-broadcast receiving device** (Fig. 2, element 27, column 5, lines 64-67); **wherein, if an incoming communication arrives from a communication partner while said display means is carrying out an operation to display an image of a program of a TV broadcast, said communication partner is informed of an end time of said program** (Fig. 2, elements 27 and 24, column 5, lines 52-67. Control unit 27 communicates with the database 24, and is informed of the end time of the currently broadcast program.).

Regarding claim 8, Sin discloses **a communication terminal comprising: a TV-broadcast receiving device configured to receive a TV broadcast** (Fig. 2, elements 25, 28 and 29, column 4, line 65 – column 5, line 8); **a display configured to display an image of a TV broadcast received by said TV-broadcast receiving device** (Fig. 2, elements 25, 28 and 29, column 4, line 65 – column 5, line 8); **a communication device configured to carrying out a**

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**communication** (Fig. 2, elements 27 and 24, column 5, lines 52-55. The control unit 27 communicates with the database 24.); **a program-end-time acquisition device configured to acquire an end time of a program of a TV broadcast received by said TV-broadcast receiving device** (Fig. 2, element 27, column 5, lines 64-67); **a storage device configured to store an incoming-reporting condition indicating whether an operation to display an image of a TV broadcast takes precedence of an operation to report an incoming communication or said operation to report an incoming communication takes precedence of said operation to display an image of a TV broadcast** (Fig. 2, elements 26 and 27, column 6, lines 3-21. The stored condition is that if the currently broadcast program has more than 5 minutes remaining, the video reproduction takes precedence, and if the currently broadcast program has less than 5 minutes remaining, the incoming communication takes precedence.); **and a setting device configured to set said incoming-reporting condition** (Fig. 2, element 27, column 6, lines 3-27, fig. 3, element S34. The condition is set based on the time remaining in the currently broadcast program.); **wherein, if an incoming communication arrives from a communication partner while said display device is carrying out an operation to display an image of a program of a TV broadcast: said communication partner is informed of an end time of said program if said incoming-reporting condition is set to indicate that said operation to display an image of a program of a TV broadcast takes precedence of an operation to report said incoming communication** (Fig. 2, elements 27 and 24, column 5, lines 52-67. Control unit 27 communicates with the database 24, and is informed of the end time of the currently broadcast program.); **and said incoming communication is reported if an incoming-reporting condition is set to indicate that an operation to report said incoming communication takes**

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**precedence of said operation to display an image of a program of a TV broadcast** (Fig. 3, element S34, column 6, lines 3-27. If less than 5 minutes are remaining, the viewer is informed of the imminent channel change, which is a report of the communication.).

Regarding claim 9, Sin discloses **a communication terminal according to claim 3 wherein said communication partner is informed of an end time of a video reproduction by transmitting a message including information on said end time of a video reproduction to said communication partner** (Fig. 2, elements 27 and 24, column 5, lines 52-67. Control unit 27 communicates with the database 24, and is informed of the end time of the currently broadcast program. A message is a short communication transmitted by words, signals, or other means from one person, station, or group to another.).

Regarding claim 11, Sin discloses **a communication terminal according to claim 7 wherein said communication partner is informed of an end time of a video reproduction by transmitting a message including information on said end time of a video reproduction to said communication partner** (Fig. 2, elements 27 and 24, column 5, lines 52-67. Control unit 27 communicates with the database 24, and is informed of the end time of the currently broadcast program. A message is a short communication transmitted by words, signals, or other means from one person, station, or group to another.).

Regarding claim 13, Sin discloses **a communication terminal according to claim 7 wherein: said TV-broadcast receiving is configured to receive a digital broadcast** (column 1, lines 64-67); **and said program-end-time acquisition device is configured to acquire an end time of a program of a TV broadcast from information included in broadcasted data of a digital broadcast received by said TV-broadcast receiving device** (column 4, lines 47-56).



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Regarding claim 18, Sin discloses **a video reproduction method for carrying out a video reproduction wherein, in the event of an incoming communication from a communication partner in the course of a video reproduction** (Fig. 2, elements 25, 28 and 29, column 4, line 65 – column 5, line 8); **an end time of said video reproduction is acquired** (Fig. 2, element 27, column 5, lines 64-67); **and said communication partner is informed of said end time of said video reproduction** (Fig. 2, elements 27 and 24, column 5, lines 52-67. Control unit 27 communicates with the database 24, and is informed of the end time of the currently broadcast program.).

Regarding claim 20, Sin discloses **a video reproduction method for carrying out an operation to display an image of a received TV broadcast wherein, in the event of an incoming communication from a communication partner in the course of an operation to display an image of a program of a TV broadcast** (Fig. 2, elements 25, 28 and 29, column 4, line 65 – column 5, line 8); **an end time of said program is acquired** (Fig. 2, element 27, column 5, lines 64-67); **and said communication partner is informed of said end time of said program** (Fig. 2, elements 27 and 24, column 5, lines 52-67. Control unit 27 communicates with the database 24, and is informed of the end time of the currently broadcast program.).

Regarding claim 21, Sin discloses **the terminal of claim 3, wherein during the video reproduction carried out by the video reproduction device, the terminal does not inform the user of the incoming communication from the communication partner** (Fig. 3, element S34, column 6, lines 3-27. If more than 5 minutes are remaining, the viewer is not informed of the communication between the control unit 27 and the database 24.).

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Regarding claim 22, Sin discloses **the terminal of claim 4, wherein when the incoming-reporting condition is set to indicate that said video reproduction takes precedence of an operation to report said incoming communication, the terminal does not inform the user of the incoming communication from the communication partner** (Fig. 3, element S34, column 6, lines 3-27. If more than 5 minutes are remaining, i.e. the incoming reporting condition is set to indicate that the video reproduction takes precedence, the viewer is not informed of the communication between the control unit 27 and the database 24.).

Regarding claim 23, Sin discloses **the terminal of claim 8, when the incoming-reporting condition is set to indicate that said TV broadcast takes precedence of the operation to report said incoming communication, the terminal does not inform the user of the incoming communication from the communication partner** (Fig. 3, element S34, column 6, lines 3-27. If more than 5 minutes are remaining, i.e. the incoming reporting condition is set to indicate that the video reproduction takes precedence, the viewer is not informed of the communication between the control unit 27 and the database 24.).

Regarding claim 24, Sin discloses **the method of claim 18, wherein during the video reproduction, the user is not informed of the incoming communication from the communication partner** (Fig. 3, element S34, column 6, lines 3-27. If more than 5 minutes are remaining, the viewer is not informed of the communication between the control unit 27 and the database 24.).

Regarding claim 25, Sin discloses **the method of claim 20, wherein during the operation to display the program of the TV broadcast, the user is not informed of the incoming communication from the communication partner** (Fig. 3, element S34, column 6,

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lines 3-27. If more than 5 minutes are remaining, the viewer is not informed of the communication between the control unit 27 and the database 24.).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 10 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sin (Pat. No.: US 7,227,583) in view of Safadi et al. (Pub. No.: US 2001/0051037).

Regarding claim 10, Sin discloses **a communication terminal according to claim 3**, but does not disclose **wherein said communication partner is informed of an end time of a video reproduction by transmitting an email including information on said end time of a video reproduction to said communication partner**. However, in analogous art, Safadi teaches that a remote server can update the end time of a program if the end time of said program changes (paragraph [0060]), and do so by sending a message to a set top box over a transmission medium, such as the internet (paragraph [0032]). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to inform a communication partner of the end time of a video reproduction by an electronic message over the internet, of which an email message is an obvious variant. This would have produced predictable and desirable results, in

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that the user would have access to the most up to date information regarding the end time of the currently viewed video program.

Regarding claim 12, Sin discloses **a communication terminal according to claim 7**, but does not disclose **wherein said communication partner is informed of an end time of a video reproduction by transmitting an email including information on said end time of a video reproduction to said communication partner**. However, in analogous art, Safadi teaches that a remote server can update the end time of a program if the end time of said program changes (paragraph [0060]), and do so by sending a message to a set top box over a transmission medium, such as the internet (paragraph [0032]). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to inform a communication partner of the end time of a video reproduction by an electronic message over the internet, of which an email message is an obvious variant. This would have produced predictable and desirable results, in that the user would have access to the most up to date information regarding the end time of the currently viewed video program.

Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sin (Pat. No.: US 7,227,583) in view of Willame et al. (Pub. No.: US 2006/0179462).

Regarding claim 14, Sin discloses **a communication terminal according to claim 7**, but does not explicitly disclose **wherein said program-end-time acquisition device is configured to acquire an end time of a program of a TV broadcast from information included in a program table distributed by an EPG**. However, in analogous art, Willame discloses receiving

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program information from an EPG, which inherently includes program end times (Willame, paragraphs [0059], lines 1-5). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to allow for the program end time to be acquired from an EPG. Because EPGs are commonly used in the art, it would have produced predictable and desirable results to incorporate using them as an information source.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JOSHUA TAYLOR whose telephone number is (571)270-3755. The examiner can normally be reached on 8am-5pm, M-F, EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vivek Srivastava can be reached on (571) 272-7304. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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Examiner, Art Unit 2426

/VIVEK SRIVASTAVA/

Supervisory Patent Examiner, Art Unit 2426